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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,574	03/25/2004	Arkady Glukhovsky	P-5817-US	5076
49443	7590	02/24/2006	EXAMINER	
PEARL COHEN ZEDEK, LLP			ROY, ANURADHA	
1500 BROADWAY 12TH FLOOR			ART UNIT	
NEW YORK, NY 10036			PAPER NUMBER	

3736

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/808,574	<b>Applicant(s)</b> GLUKHOVSKY, ARKADY	
	<b>Examiner</b> Anuradha Roy	<b>Art Unit</b> 3736	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/25/04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 21-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/25/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Restrictions/Election**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20, drawn to an in-vivo device.
- II. Claims 21-27, drawn to a method for in vivo sensing.
- III. Claims 28-34, drawn to a method for viewing the upper GI tract.

The inventions are distinct because of the following reason:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process, such as a method for viewing the upper GI tract.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product, such as in vivo sensing of other organs within the body.

During a telephone conversation with Caleb Pollack on February 7, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-20. Affirmation

of this election must be made by applicant in replying to this Office action. Claims 21-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 9, 11, 12, 14, & 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Shan et al. (US Patent No. 5,984,860).

Regarding claim 1, Shan et al. discloses an in-vivo device comprising:

a substantially spherical housing (10),

said housing comprising a sensor (18);

and a detachable appendage (24).

In regards to claim 2, Shan et al. discloses a device, wherein the sensor is an imager (18 & Column 3, lines 53-54).

Regarding claim 4, Shan et al. discloses a device, wherein the housing includes a viewing window (18 & Column 3, lines 61-63).

Regarding claim 9 & 19, Shan et al. discloses a device, wherein the appendage comprises: an inherent outer coating (24); and inherently contains an internal filling of air.

With regard to claim 11, Shan et al. discloses an ingestible imaging device comprising: a substantially spherical imaging device (Figure 4); and a detachable appendage (24).

Regarding claim 12, Shan et al. discloses a device comprising: an illumination source (20); and a transmitter (26 & 28).

Regarding claim 14, Shan et al. discloses a device comprising a ballast weight (Figure 1). This in-vivo device inherently has a ballast weight.

#### **Additional Claim Rejections - 35 USC § 102**

Claims 1, 2, 4, 5, 6, 11, 14, 15, & 16 rejected under 35 U.S.C. 102(b) as being anticipated by Madni et al. (US Patent No. 6,007,482).

Regarding claim 1, Madni et al. discloses an in-vivo device comprising:

a substantially spherical housing (10),  
said housing comprising a sensor (12);  
and a detachable appendage (27).

In regards to claim 2, Madni et al. discloses a device, wherein the sensor is an imager (12).

Regarding claim 4, Madni et al. discloses an device, wherein the housing includes a viewing window (17).

With regard to claim 11, Madni et al. discloses ingestible imaging device comprising: a substantially spherical imaging device (Figure 1); and a detachable appendage (27).

Regarding claims 5, 6, 15, & 16, Madni et al. discloses a device, wherein the appendage includes a degradable material and is pH sensitive (Column 2, lines 1-6 & 27-35). It is noted that latex material is inherently degradable and pH sensitive.

In regard to claim 14, Madni et al. discloses a device comprising a ballast weight. This in-vivo device inherently has a ballast weight.

#### **Additional Claim Rejections - 35 USC § 102**

Claims 1, 2, 3, & 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al. (US Patent No. 6,719,684).

Regarding claim 1, Kim et al. discloses an in-vivo device comprising:

a substantially spherical housing (20),  
  
said housing comprising a sensor (11);  
  
and a detachable appendage (25a).

Regarding claim 2, Kim et al. discloses device, wherein the sensor is an imager (11).

In regards to claim 3, Kim et al. discloses a device, wherein the imager is a CMOS imager (Column 3, line 30).

Regarding claim 11, Kim et al. discloses an ingestible imaging device comprising: a substantially spherical imaging device (Figure 1a & 1b); and a detachable appendage (25a).

Regarding claim 12, Kim et al. discloses a device comprising: an illumination source (12); and a transmitter (16).

With regards to claim 13, Kim et al. discloses a device, wherein the illumination source (12) has intensity that is adjustable in vivo (Column 3, lines 35-40).

Regarding claim 14, Kim et al. discloses a device comprising a ballast weight (Figure 1a & 1b). This in-vivo device inherently has a ballast weight.

#### **Additional Claim Rejections - 35 USC § 102**

Claims 1, 9, 10, 11, 14, 19, & 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kovacs et al. (US Patent No. 5,833,603).

Regarding claim 1, Kovacs et al. discloses an in-vivo device comprising:

a substantially spherical housing (44),

said housing comprising a sensor (32);

and a detachable appendage (128).

With regard to claim 11, Kovacs et al. discloses an ingestible imaging device comprising:  
a substantially spherical imaging device (Abstract); and a detachable appendage (128).

Regarding claim 9 & 19, Kovacs et al. discloses a device, wherein the appendage comprises: an inherent outer coating (126); and inherently contains an internal filling of air and other elements of the device.

In regards to claims 10 & 20, Kovacs et al. discloses a device, wherein the outer coating is semi-permeable (Column 15, lines 25 - 35).

Regarding claim 14, Kovacs et al. discloses a device comprising a ballast weight (Figure 10). This in-vivo device inherently has a ballast weight.

#### **Additional Claim Rejections - 35 USC § 102**

Claims 1, 5-8, 11, & 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Snow (US Publication No. 2002/0198440).

Regarding claim 1, Snow discloses an in-vivo device comprising:

a substantially spherical housing (10),

said housing comprising a sensor (Claim 1);

and a detachable appendage (12, 16, & 30).

It is noted that an endoscopic gastrostomy device inherently has a sensor, since it contains an endoscope.

Regarding claim 7, Snow discloses a device, wherein the appendage and the spherical housing are glued together (Claim 11, [0028], & [0043]).

Regarding claim 8, Snow discloses a device, wherein the appendage and the spherical housing are glued together using dissolvable glue ([0048]).

Regarding claim 11, Snow discloses an ingestible imaging device comprising: a substantially spherical imaging device (Claim 1); and a detachable appendage (12, 16, & 30).

Regarding claims 5, 6, 15, & 16, Snow discloses a device, wherein the appendage includes a degradable material and is pH sensitive (Column 2, lines 1-6 & 27-35). It is noted that a degradable material is inherently pH sensitive.

With regard to claim 14, Snow discloses a device comprising a ballast weight (Figure 1a & 1b). This in-vivo device inherently has a ballast weight.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anuradha Roy whose telephone number is (571) 272-6169 and

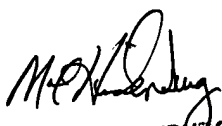
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whose email address is [anuradha.roy@uspto.gov](mailto:anuradha.roy@uspto.gov). The examiner can normally be reached between 8:00am and 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~AR~

  
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